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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/593,289	06/13/2000	Paul E. Bender	PA000322	7796
23696	7590	11/26/2004	EXAMINER NGUYEN, STEVEN H D	
Qualcomm Incorporated Patents Department 5775 Morehouse Drive San Diego, CA 92121-1714			ART UNIT 2665	PAPER NUMBER

DATE MAILED: 11/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/593,289	Applicant(s) BENDER ET AL.	
	Examiner Steven HD Nguyen	Art Unit 2665	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 August 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 8/3/04 has been entered.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 23-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As claims 23-24, line 3, "the second radio network" does not refer to any previous element. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 1-20 and 22-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Holmes (USP 6230009) in view of Silver (USP 6560457) and Stephens (USP 6600920).

Holmes discloses (Figs 1-4 and col. 1, line 5 to col. 4, line 12) a method for receiving messages forwarded from a second radio network (Fig 2, Ref 201) to a first radio network (Fig 2, Ref 252) by establishing a session with the first radio network (Fig 4, Ref 402); sending to the first radio network an first message for indication of an interest in receiving unsolicited messages for a particular set of service options from the second radio network (Fig 4, Ref 403, the mobile notifies the second network must transmit a page message via PCCH of the first network to the mobile) and registering with the second network before receiving a page message (Fig 4, Ref 401) and the unsolicited messages are sent from the second radio network to the first radio network. (Fig 2); the encapsulated message is received from the first radio network on a designated control channel cycle (Fig 2, Ref PCCH). However, Holmes does not disclose the page message must be encapsulating in order to transmit via the PCCH. In the same field of endeavor, Silver discloses (Figs 1-6 and col. 1, line 17 to col. 9, line 67) receiving an encapsulated message from the first radio network, wherein the encapsulated message includes

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an unsolicited message from the second radio network that has been forwarded to the first radio network (Figs 3-4 wherein the mobile receives an encapsulating from the first network via PCCH wherein the encapsulated includes a received unsolicited message "page message" from the second network; See col. 6, lines 1-48) and the first message is sent periodically within a first time interval and the encapsulating and forwarding of the unsolicited messages from the second radio network cease if the first message is not received within a second time interval, wherein the second time interval is longer than the first time interval and sending a second message to the first radio network to request termination of the encapsulating and forwarding of the unsolicited messages from the second radio network. (Col. 7, lines 12-30, the mobile periodically notifies its present to receive the messages and the first network will not forward the message if it does not receive the notified message and it is implicitly discloses if the mobile does not want to receive the message via PCCH, its will send a disconnection message to the first network) and sending a page response message to the second radio network in response to receiving the encapsulated message from the first radio network (Figs 3-4 and Page RESP on DCCH); the encapsulated message received from the first radio network is a paging request message; a voice page; the first radio network is a High Data Rate radio network; the second radio network is a CDMA radio network that conforms to IS-2000 standard. (Col. 4, lines 40-62 and col. 6, lines 1-31 and Fig 2, HDR is data network 120 and CDMA-2000 is voice network 110) and it is well known and expected in the art for an encapsulated message includes an Access Terminal Identifier (ATI) Record field indicative of an address of a recipient access terminal, a Message ID field that indicates that the message is an encapsulated message, and a message field indicative of one or more paging records for the recipient access terminal for forwarding via forward channel.

However, Holmes and Silver fail to disclose the first radio network continues to send the encapsulated message until the first radio network receives a message to stop encapsulation. In the same field of endeavor, Stephens discloses (Figs 1-10 and col. 1, line 16 to col. 7, line 22) a system comprising a mobile transmitting a suspend message via PCCH to the SGSN in order to notify the packet network to stop transmitting encapsulating message to the mobile and establishing a connection with the second radio network in response to receiving the encapsulated message and the unsolicited messages are sent from a mobile station controller to the first and second radio networks (Fig 7-10, Ref 113 discloses after receiving a page message via PCCH, the mobile sends a suspend message to the packet network in order to notify the packet network, the mobile does not want to receive a page message, Ref 111 via PCCH, REF 89, when its tuning to the DCCH, Ref 115, of the second network for transmitting a page response, Ref 115, See col. 5, lines 22-46, col. 6, lines 1-13 and 27-46).

Since, Holmes suggests that MDIS creating a IP packet for transmitting via PCCH to the mobile for alerting an incoming call and Silver suggests the packet network will not forward the encapsulating message if it does not receive a message from the mobile within a time interval for continuing receiving the page message. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to apply a method and system for receiving a page message from a packet network and transmitting a suspension message to the packet network for notify the packet message already receiving the page message as disclosed by Stephens' method and system to the method and system of Silver in order to improve the throughput of the packet network by encapsulating a received page message from the second network at the first network for transmitting to the mobile station as disclosed by Silver into

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Holmes' system and method. The motivation would have been to reduce a delay for setting up a telephone call and improve through put of the packet network.

7. Claims 21 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Holmes (USP 6230009) in view of Silver (USP 6560457) and Stephens (USP 6600920) and Chevillat (USP 6181683).

Holmes, Silver and Stephens disclose the claimed invention as set forth of the claims 1-20 and 22-25 of paragraph 6 of the office action. However, Holmes, Silver and Stephens do not fully disclose a transceiver for modulating the coded data and converting the modulated data into modulated signal suitable for transmitting via medium and demodulating the received signal and decoding the demodulated data to recover the transmitted data and controller. In the same field of endeavor, Chevillat discloses (Figs 2 and 5) a transceiver for modulating the coded data and converting the modulated data into modulated signal suitable for transmitting via a medium and demodulating the received signal and decoding the demodulated data to recover the transmitted data and controller.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to apply a method for modulating the coded data and converting the modulated data into modulated signal suitable for transmitting via a medium and demodulating the received signal and decoding the demodulated data to recover the transmitted data and controller as disclosed by Chevillat's system into the system of Holmes, Stephens and Silver. The motivation would have been to reduce a delay for setting up a telephone call.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven HD Nguyen whose telephone number is (571) 272-3159. The examiner can normally be reached on 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Huy D Vu can be reached on (571) 272-3155. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Steven HD Nguyen
Primary Examiner
Art Unit 2665
11/18/04